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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/909,300  | 07/19/2001  | Jiro Oishi           | CU-2599 WDD         | 1834             |
| 7990 01/21/2004   |             |                      |                     |                  |
| Ladas & Parry<br>Suite 1200<br>224 South Michigan Avenue<br>Chicago, IL 60604 |             |                      |                     |                  |
| EXAMINER<br>ZIRKER, DANIEL R  |             |                      |                     |                  |
| ART UNIT<br>1771  |             | PAPER NUMBER         |                     |                  |

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Advisory Action

Application No.

09/909,300

Applicant(s)

ONISHI ET AL.

Examiner

Daniel Zirker

Art Unit

1771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## THE REPLY FILED

FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## PERIOD FOR REPLY (check either a) or b))

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 708.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
 2. ☒ The proposed amendment(s) will not be entered because:  
 (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ they raise the issue of new matter (see Note below);  
 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached NOTE.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.  
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 6-20.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
 10. ☐ Other: \_\_\_\_\_

DANIEL ZIRKER  
 PRIMARY EXAMINER  
 GROUP 1800

1700

*Daniel Zirker*

## NOTE

1. The Examiner notes that there appears to be a significant number of new issues in the extensively amended claims in this after final communication; the Examiner will attempt to point out several of these but notes that others may well exist. In claim 6, line 8, the phrase "formed of a resin other than ionomer" is a new issue with respect to the attempted exclusion of ionomers from the class of suitable resins. Additionally, three lines down it is noted that claim 6 has no dependent claims which were cancelled that contained a recitation regarding paper having certain Bec's smoothness parameter, which limitation has been incorporated into the new claims and is also considered a new issue. Additionally, in claim 6 the deletion of the phrase "formed of a different material from a material of the uppermost layer" clearly changes the scope of the claims. In claim 18, line 11 the recitation that the receptor layer is "of ~~a~~<sup>the</sup> intermediate transfer recording medium" and also that the basement layer is "formed of an ionomer" are each new issues since neither of these parameters are found in the dependent claims of claim 18. Finally, the Examiner again reiterates that it is believed that a significant number of other new issues may well exist in the newly presented claims, and the Examiner further urges that if future prosecution is contemplated, the application be refiled so that such issues as those set forth

Art Unit 1771

above by the Examiner, as well as others not specifically discussed herein may be given the attention that they deserve.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

Dzirker:cdc

January 12, 2004